

REMARKS

Applicant has carefully studied the Office Action of December 13, 2004, and offers the following remarks to accompany the above amendments.

Initially, Applicant cancels claims 8 and 19, directed to a wavelength select switch comprising a crossbar switch, without prejudice. As Applicant has canceled claims 8 and 19, the objection to the drawings and the rejection of claims 8 and 19 under 35 U.S.C. § 112 is moot.

Claims 13, 16 and 20-23 are amended to correct antecedent basis issues. No new matter is added.

Before addressing the rejections proper, Applicant sets forth the standard under which references may be combined. Applicant is cognizant of the fact that most inventions are combinations of known elements. One of the things that makes an invention patentable over the prior art is that it would not have been obvious to someone of ordinary skill in the art to combine the prior art and arrive at the claimed invention. The Federal Circuit and the MPEP make it clear that when the Patent Office rejects a claim under an obviousness analysis, the Patent Office may not rely on impermissible hindsight to pick and choose elements from the references to deprecate the claimed invention. One of the ways to reduce the instances of impermissible hindsight reconstruction is the requirement that the Patent Office articulate a motivation to combine the references, and also that the Patent Office support the motivation to combine the references with **actual evidence**. *In re Dembicza*k, 175 F.3d 994, 999 (Fed. Cir. 1999). In *Dembicza*k, the Federal Circuit acknowledged that there are myriad sources of motivation, but that the range of the available sources **did not diminish the requirement for actual evidence**.

In the present case, the Patent Office has not provided any evidence to support the articulated motivations to combine the references. Since the Patent Office has not complied with the instructions from the Federal Circuit, the combinations are improper. Since the combinations are improper, the rejections are improper as is further explained below.

Claims 1-3, 6, 12-14, and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Prohaska in view of Felger et al. (hereinafter "Felger"). Applicant respectfully traverses. The standard for combining references is set forth above. To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is shown in the prior art. MPEP § 2143.03.

The Patent Office admits that Prohaska does not teach measuring the power of the selected optical signal with a power meter, but opines that Felger teaches a power meter. The Patent Office then opines that the combination would be obvious "to measure the optical power of one optical signal channel separated from the plurality of input optical signals of the system." The articulated motivation to combine the references lacks the evidence required by the Federal Circuit to support a motivation to combine references. There is no evidence, outside of Applicant's disclosure, that there is any need in the prior art to measure the optical power of one optical signal channel separated from the plurality of input optical signals of the system, and therefore there is no reason to combine the references. Since there is no reason to combine the references, the combination is improper, and the references must be considered individually.

Individually, the references do not establish obviousness. The Patent Office admits that Prohaska does not teach an element and therefore, Prohaska alone cannot establish obviousness. Likewise, the Patent Office has not articulated where in Felger all the elements are taught or suggested, so Felger alone cannot establish obviousness. Since the references individually do not establish obviousness, and the combination of references is improper, the rejection does not establish obviousness for claims 1-3, 6, 12-14, and 17. Applicant requests withdrawal of the § 103 rejection of claims 1-3, 6, 12-14, and 17 at this time.

Claims 1-7, 10-18, and 20-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Itou et al (hereinafter "Itou") in view of Ball. Applicant respectfully traverses. The standard for combining references is set forth above as is the standard for establishing obviousness.

The Patent Office admits that Itou does not teach a wavelength selective switch or the use of the wavelength selective switch to select a signal, but opines that Ball teaches such a wavelength selective switch and its use. The Patent Office then opines that it would be obvious to replace the tunable filter of Itou with the wavelength selective switch of Ball "to direct the selected wavelength to the power meter and those un-selected optical signal channels to an output port for monitoring spectral shape of the signals." The articulated motivation to combine the references lacks the evidence required by the Federal Circuit to support a motivation to combine references. There is no evidence, outside of Applicant's disclosure, to direct an isolated signal to a power meter, and therefore, there is no reason to combine the references. Since there

is no reason to combine the references, the combination is improper, and the references must be considered individually.

Individually, the references do not establish obviousness. The Patent Office admits that Itou does not teach an element and therefore, Itou alone cannot establish obviousness. Likewise, the Patent Office has not articulated where in Ball all the elements are taught or suggested, so Ball alone cannot establish obviousness. Since the references individually do not establish obviousness, and the combination of references is improper, the rejection does not establish obviousness for claims 1-7, 10-18, and 20-23. Applicant requests withdrawal of the § 103 rejection of claims 1-7, 10-18, and 20-23 at this time.

Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Itou in view of Ball, in further view of Felger. Applicant respectfully traverses. The standard for combining references is set forth above, as is the standard for establishing obviousness.

Applicant initially traverses the rejection because the rejection relies on the combination of Itou and Ball, which, as discussed above, is improper.

Applicant further traverses the combination of Felger with Itou and Ball. The Patent Office admits that the combination of Itou and Ball does not teach a display of an indication of the power in the optical signal, but opines that Felger teaches such a display. The Patent Office then opines that it would be obvious to use the power meter of Felger with the combination of Itou and Ball "to display the measured optical power." The articulated motivation to combine the references lacks the evidence required by the Federal Circuit to support a motivation to combine references. There is no evidence, outside of Applicant's disclosure, to display the measured optical power, and therefore, there is no reason to combine the references. Since there is no reason to combine the references, the combination is improper, and the references must be considered individually.

The Patent Office admits that the combination of Itou and Ball does not teach an element and therefore, this combination alone cannot establish obviousness. Likewise, the Patent Office has not articulated where in Felger all the elements are taught or suggested, so Felger alone cannot establish obviousness. Since the references individually do not establish obviousness, and the combination of references is improper, the rejection does not establish obviousness for claim 9. Applicant requests withdrawal of the § 103 rejection of claim 9 at this time.

Applicant requests reconsideration of the rejections in light of the amendments and remarks presented herein. The Patent Office has not satisfied its burden in establishing obviousness because the Patent Office has not provided actual evidence to support the combinations advanced in the obviousness rejections. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:

Benjamin S. Withrow
Registration No. 40,876
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

Date: February 7, 2005
Attorney Docket: 7000-209

CERTIFICATE OF TRANSMISSION
I HEREBY CERTIFY THAT THIS DOCUMENT IS BEING
TRANSMITTED VIA FACSIMILE ON THE DATE INDICATED BELOW
TO:

Examiner: Wang, Quan Zhen Art. Unit: 2633 Fax: 703-872-9306

REBECCA Rooks

Name of Sender

Rebecca S. Rooks

Signature

2/7/05

Date of Transmission